

REMARKS/ARGUMENTS

Claims 35-64 are pending. The Office Action rejects claims 35-58 as being unpatentable over various combinations of Gifford, Bishop, and other references.¹ By this Amendment, claims 59-64 are new. Support for the new claims can be found throughout the specification, drawings, and claims as originally filed; no new matter has been added.²

New Claims 59-64

Claim 59 depends from independent claim 35, and recites that the step of linking the PKI key pair to the payment instrument is performed prior to the step of receiving the buyer's selection of the payment instrument. In rejecting claim 35, the Office Action cites to portions of Gifford that describe a "smart card including a secret key is used to sign the payment order" as disclosing the recited linking step, and a user interface for providing account information in Gifford's Figure 4 as disclosing a user selecting a payment instrument.³

The interface shown in Figure 4, however, obtains information used to construct a payment order from the user:

FIG. 4 is a missing payment information document that is used to gather user account information for the requested purchase in an HTML form. Radio buttons 8, 9, 10, 11, 12 are used to **select a means of payment**, **dialog box 13 is used to enter an account number**, dialog box 14 is used to enter an optional authenticator for the account, purchase button 15 is used to **send the account information to the merchant computer** and proceed with the purchase, link 16 is used to abort the purchase and return to the document shown in FIG. 2, and dialog box 17 is used to enter optional user information that is associated with the purchase and ultimately used by a financial institution as part of a textual billing identifier for the purchase transaction. If provided, this additional information is included in the payment order for the purchase.⁴

This payment order is **subsequently** processed by an authenticator, such as with the Smart-Card signing technique cited by the Office Action as disclosing the recited "linking" step. Notably,

¹ U.S. Patent No. 6,205,437 to Gifford; U.S. Pub. No. 2004/0243520 to Bishop; U.S. Pub. No. 2001/0044787 to Schwartz; U.S. Pub. No. 2001/0014158 to Baltzley.

² See, e.g., Figs. 2-3; p. 8, p. 17-24; p. 10, lines 20-26; p. 11, lines 7-26; p. 15, line 23 – p. 17, line 11.

³ Office Action mailed January 12, 2009, p. 3.

before any interaction can occur with the Smart-Card, the user must **first** select the account number cited as disclosing the recited payment instrument. For example, referring to Figure 14, Gifford's system first constructs a payment order at step 79, such as using the interface shown in Figure 4, and **then** constructs an authenticator at step 80. All of Gifford's other examples similarly begin with a payment order being constructed before any authentication or other key-related processing is performed.⁵

Accordingly, even if the cited portions of Gifford disclose the features as alleged by the Office Action, which Applicants do not concede, they fail to disclose first linking a payment instrument to a PKI key pair and **subsequently** receiving a selection of the payment instrument from a buyer as recited in claim 59. In fact, since Gifford's methods always obtain payment information from the user before performing any authentication or similar processes, they cannot perform the steps cited by the Office Action in the order recited in claim 59. For at least this reason, claim 59 is allowable over the art as applied by the Office Action.

Claims 61 and 63 recite similar features, and claims 60, 62, and 64 depend from claims 59, 61, and 63, respectively. Hence, these claims are allowable for at least the same reason as claim 59.

Claims 56-58

To support a *prima facie* case of obviousness, the Examiner must show that each claimed feature is shown in the cited art or provide reasoning to support the finding that the features would be obvious at the time the invention was made.⁶ In addition, an obviousness rejection cannot be sustained by mere conclusory statements; there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.⁷

Claims 56-58 recite, *inter alia*,

⁴ Gifford, col. 5, lines 33-47 (emphasis added).

⁵ See, e.g., Figs. 12, 14, and 15 and related text.

⁶ M.P.E.P. §§2141, 2142.

⁷ M.P.E.P. §§ 2141, 2142 (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 at 1396 (2007)).

receiving confirmation that the buyer is authorized to use the first payment instrument **prior to** receiving the authorization request and **prior to** receiving the selection of the first payment instrument.

In rejecting these claims under §103, the Office Action merely states that “the combination of Gifford, Bishop, and Shwartz discloses these features” and references an earlier rejection of claims 35 and 42.⁸ **Claims 35 and 42, however, do not recite “receiving confirmation that the buyer is authorized to use the first payment instrument” at all.** Hence, the Office Action fails to show that the cited combination of references discloses at least this feature, or to provide any reasoned explanation of why this feature would be obvious to one of skill in the art based on the cited references. For at least this reason the rejection of claims 56-58 is improper.

Further, even if the cited references disclose the features of receiving confirmation that the buyer is authorized to use the first payment instrument, receiving the authorization request, and receiving the selection of the first payment instrument (which Applicants do not concede), the Office Action fails to provide a reasoned explanation of why it would be obvious to receive confirmation that the buyer is authorized to use the first payment instrument **prior to** receiving the authorization request and **prior to** receiving the selection of the first payment instrument. For example, the Office Action cites to Gifford’s payment order as disclosing the recited receiving the authorization request (see Office Action p. 4), and Gifford’s “missing payment information document” as disclosing the recited “receiving selection of the first payment instrument” (see Office Action p. 5-6). No reasoning is provided by the Office Action to demonstrate why one of skill in the art would modify Gifford to first receive confirmation that the buyer is authorized to use the first payment instrument **before** receiving a payment order or a missing payment information document. Hence, the Office Action’s rejection of these claims based on the earlier rejection of claims 35 and 41 is simply not supported by the cited references.

For at least these reasons, the Office Action fails to provide explicit reasoning sufficient to support a *prima facie* case of obviousness with respect to at least claims 56-58.

⁸ Office Action, p. 8.

Claims 35-55

To support a *prima facie* case of obviousness, the Examiner must demonstrate that each feature recited in the claims is found in the cited art, or provide explicit reasoning to support the finding that the features would be obvious to one of skill in the art at the time the invention was made.⁹

Independent claim 35 recites **linking a PKI key pair to a first payment instrument** of a buyer and **receiving a selection of the first payment instrument** from the buyer. Independent claims 42 and 49 recite similar features.

As described above with respect to claims 59-64, the Office Action asserts that Gifford discloses linking the PKI key pair to at least a **first payment instrument** in a description of signing a payment order with a Smart-Card. It appears the Office Action interprets a secret key in the Smart-Card as the recited PKI key pair, and the payment order as the recited payment instrument. The Office Action also asserts that Gifford discloses a **plurality of payment instruments** in a description of a missing information document in which a user can provide an account number.¹⁰ Apparently, the Office Action also interprets the type of account and/or the account number as disclosing the recited payment instrument.

Regardless of whether either interpretation is appropriate, which Applicants do not concede, they are inconsistent and cannot both be correct. If the Office Action correctly interprets the account in Figure 4 as a payment instrument, then the Office Action is incorrect in asserting that this “payment instrument” is linked to a PKI key pair - the Smart-Card merely signs a completed payment order, it is not linked to a particular account type or number. If the Office Action correctly interprets the payment order as disclosing the recited payment instrument, then Gifford does not disclose a plurality of payment instruments in Figure 4 because no completed payment instruments are shown in Figure 4. Under either interpretation, the Office Action fails to show that Gifford discloses at least one of these features and, therefore, fails to establish a *prima facie* case of obviousness with respect to claims 35, 42, and 49.

⁹ See M.P.E.P. §§ 2141, 2142.

¹⁰ See Office Action, p. 3.

CONCLUSION

Each of the pending dependent claims is allowable for at least the same reason as the independent claim from which it depends, and is patentable for additional reasons. Thus, in view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 202-481-9900.

The Commissioner is authorized to charge any fees due or credit any overpayment to the deposit account of Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430.

Respectfully submitted,

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